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Docket No.: 200308992-1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Thomas J. Connor et al.

Application No.: 10/658,713

Confirmation No.: 2781

Filed: September 9, 2003

Art Unit: 3653

For: SYSTEM AND METHOD FOR DE-SKEWING
MEDIA WHEN USING AN AUTOMATIC
MEDIA FEEDER

Examiner: K. S. Joerger

REPLY BRIEF (37 C.F.R. 41.41)

MS Appeal Brief - Patents
Commissioner for Patents
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ATTENTION: BOARD OF PATENT APPEALS AND INTERFERENCES

As required under § 41.41(a)(1), this Reply Brief is filed within two months of the Examiner's Answer dated December 21, 2006, and is in furtherance of the Appeal Brief filed on August 23, 2006.

No fee is required for this REPLY BRIEF.

This brief contains items under the following headings pursuant to M.P.E.P. § 1208:

- I. Status of Claims
- II. Ground of Rejection to be Reviewed on Appeal
- III. Remarks
- IV. Conclusion

I. STATUS OF CLAIMS

The status of claims remains as identified in the Appeal Brief submitted August 23, 2006, wherein claims 1-25 stand rejected and are presented for appeal.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed remain as identified in the Appeal Brief submitted August 23, 2006.

III. REMARKS

In the Appeal Brief, Appellant argued many of the rejected claims separately, and thus respectfully asserts that the separately argued claims do not stand or fall together. See 37 C.F.R. §41.37(c)(1)(vii). Appellant hereby incorporates and reasserts the arguments presented in the Appeal Brief, but for brevity, does not repeat all the arguments herein. Rather, Appellant addresses the remarks contained in the Examiner's Answer. However, in no way does the organization of the arguments cause such one or more claims to be considered together rather than separately.

A. Evidence Relied Upon

Appellant would like to point out that Appellee relied upon the English translation of JP 01181654 A to Kazunobu et al. (hereinafter "*Kazunobu*") in the Examiner's Answer. Appellee has introduced the English translation of *Kazunobu* for the first time as evidence.

B. The 35 U.S.C. § 102(b) Rejections over *Kazunobu*

Claims 1-10 and 12-13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Kazunobu*. See Final Office Action at page 2. Appellant replies herein to the Examiner's Answer with regard to the 35 U.S.C. § 102(b) rejections over *Kazunobu*.

Appellant presented arguments showing that each of claims 1-10 and 12-13 contain features that are not taught by *Kazunobu*. See Appeal Brief at pages 5-9. For example,

Appellant has shown that *Kazunobu* does not teach “a registration tab disposed to deflect an edge of said media when the media passes over the registration tab,” as recited in independent claim 1. See Appeal Brief at pages 5 and 6. According to *Kazunobu*, pressure plate 13 is separated from original 200 by white sheet 9. As such, original 200 does not pass over pressure plate 13 and pressure plate 13 is not disposed to deflect an edge of original 200, much less deflect an edge of original 200 when original 200 passes over pressure plate 13. Accordingly, *Kazunobu* is insufficient to meet every element of independent claim 1 under 35 U.S.C. § 102.

In response, the Examiner emphasizes that the registration tab (pressure plate 13) acts on white sheet 9, which then acts on original 200 to deflect original 200 downward onto the platen and into abutting alignment with the registration guide (butting plate 101). See Examiner’s Answer at pages 6-7. The Appellee’s reasoning is that the white sheet 9 is an intermediate feature to facilitate the deflection of the original 200 by the registration tab (pressure plate 13) and, therefore, the registration tab (pressure plate 13) does ultimately deflect the original 200. The Appellee asserts that figure 2b shows that the registration tab (pressure plate 13) serves to deflect or push the trailing edge of the original down so that it can abut registration guide (butting plate 101) as the sheet passes over the registration tab (pressure plate 13). The Examiner’s argument is incorrect for at least two reasons.

First, the only thing figure 2b shows concretely is that sheet 9 prevents original 200 from feeding over butting plate 101. Nowhere in figure 2b can Appellant find support for Appellee’s assertions. Figure 2b does not show sheet 9 pushing original 200 down when original 200 passes over pressure plate 13. In contrast to the claim 1 language, figure 2b shows sheet 9 pushing original 200 down at a point when original 200 is not in juxtaposition with any part of the pressure plate 13, which is applying a biasing force to sheet 9.

Second, even assuming *arguendo* that sheet 9 does deflect original 200 down, the point at which sheet 9 is deflected downward cannot be determined from figure 2b. Nowhere in figure 2b can Appellant find support for Appellee’s assertions that sheet 9 pushes original 200 down when original 200 passes over pressure plate 13. Applicant respectfully reminds the Examiner

that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art," *see* M.P.E.P. § 2143.03.

Appellant has also shown that *Kazunobu* does not teach "wherein said registration tab comprises a member presenting a sloped surface to said edge of said media . . ." as recited in claim 4. *See* Appeal Brief at page 7. In fact, *Kazunobu* teaches that pressure plate 13 is at all times separated from original 200 by sheet 9 and does not present a sloped surface 13a to original 200. Accordingly, *Kazunobu* is insufficient to meet every element of claim 4 under 35 U.S.C. § 102.

In response, the Appellee once again emphasizes that white sheet 9 is an intermediate feature to facilitate the deflection of the original 200 by the registration tab (pressure plate 13) and, therefore, the registration tab (pressure plate 13) does ultimately deflect the original 200. *See* Examiner's Answer at page 7.

Such argument is not relevant to the question of anticipation under 35 U.S.C. § 102. Appellant respectfully reminds the Appellee that in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim," *see* M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Claim 4 requires that the registration tab comprises a member presenting a sloped surface to said edge of said media. Regardless of whether pressure plate 13 of *Kazunobu* deflects original 200 directly or indirectly through sheet 9, pressure plate 13 does not present a sloped surface to original 200.

Additionally, the Appellee states that Appellant's argument holds no weight because it is analogous to one arguing that if a sheet feeding roller was covered by a rubber material, then the roller, because the rubber material is between the sheet and the roller, is not actually acting on the sheet. *See* Examiner's Answer at page 7. Appellant would like to point out that Appellee's example above is not analogous to Appellant's argument at all. First, claim 4 requires that pressure plate 13 present a sloped surface 13a to original 200, not that pressure plate 13 act on original 200. Second, sheet 9 of *Kazunobu* is not part of pressure plate 13 and as such, does not

define sloped surface 13a of pressure plate 13. Appellant sustains the validity of the argument set forth in the Appeal Brief which states that sheet 9 physically separates sloped surface 13a from original 200 and, therefore, sloped surface 13a is not ever presented to original 200 as required by claim 4.

Appellant has also shown that *Kazunobu* does not teach “wherein said registration tab has a smooth outer surface to slidably direct said media,” as recited in claim 12. See Appeal Brief at page 8. *Kazunobu* teaches that pressure plate 13 is at all times separated from original 200 by sheet 9 and does not present a sloped surface 13a to original 200. As such, sloped surface 13a does not slidably direct original 200. Accordingly, *Kazunobu* is insufficient to meet every element of claim 12 under 35 U.S.C. § 102.

In response, the Appellee argues that white sheet 9 serves as an extension of the surface of the registration tab (pressure plate 13) and, therefore, is the smooth outer surface (sloped surface 13a) of the registration tab (pressure plate 13). Additionally, the Appellee states that the translation of *Kazunobu* teaches a smooth outer surface of the tab (pressure plate 13). See Examiner’s Answer at page 8.

Such argument is not relevant to the question of anticipation under 35 U.S.C. § 102. Appellant respectfully reminds the Appellee that in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Claim 12 requires that the registration tab have a smooth outer surface to slidably direct the media. Regardless of whether or not sheet 9 serves as an extension of pressure plate 13, sheet 9 is not sloped surface 13a. Therefore, regardless of whether or not sheet 9 slidably directs original 200, sloped surface 13a of pressure plate 13 does not slidably direct original 200 as required by claim 12.

C. The 35 U.S.C. § 103 Rejections over *Kazunobu*

Claims 11 and 16-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Kazunobu*. See Final Office Action at pages 2-5. Appellant replies herein to the Examiner's Answer with regard to the 35 U.S.C. § 103 rejections over *Kazunobu*.

Appellant presented arguments showing that each of claims 11 and 16-25 contain features that are not taught by *Kazunobu*. See Appeal Brief at pages 9-18. For example, Appellant has shown that *Kazunobu* does not teach or suggest "wherein said media comprises photographic media," as recited in claim 11. See Appeal Brief at pages 9-10. Appellant has also shown that *Kazunobu* does not teach or suggest "photographic media," as recited by claim 21. See Appeal Brief at pages 16-18. Appellant established that one of ordinary skill in the art would not be inclined to use photographic media with the de-skewing system taught by *Kazunobu*. Additionally, Appellant established that *Kazunobu* does not teach or suggest a desirability for making the combination. Accordingly, *Kazunobu* does not render obvious claims 11 and 21 under 35 U.S.C. § 103.

In response, the Appellee merely referenced the same grounds of rejection made in the Final Office Action and did not address any of the arguments raised in the Appeal Brief. See Examiner's Answer at pages 8-9. Appellant respectfully reasserts that claims 11 and 21 are patentable over the rejections of record at least for the reasons presented in the Appeal Brief.

Appellant has also shown that *Kazunobu* does not teach "wherein said registration tab is cast as a monolithic member of said movable lid portion . . .," as recited in claim 23. See Appeal Brief at page 18. *Kazunobu* discloses a pressure plate 13 to aid in registration of media and does not teach or suggest a registration tab cast as a monolithic member of the movable lid portion. Accordingly, *Kazunobu* does not render obvious claim 23 under 35 U.S.C. § 103.

In response, the Appellee claims that *Kazunobu* teaches a monolithic member in the sense that a monolithic member is a member that acts as a single powerful force to deflect the sheet media. Appellant disagrees with Appellee's argument.

Claim 23 requires a registration tab cast as a monolithic member of the movable lid portion. Appellant asserts that pressure plate 13 is not cast as a monolithic member of the movable lid. *See* Figures 2a, 2b, and 3. In contrast, pressure plate 13 is a separate member. As described in Appellant's specification, registration tabs cast as monolithic members of the lid portion are non-movable tab configurations. *See* [0024]. In contrast, pressure plate 13 moves independent of the movable lid. *See* Figures 2a, 2b, and 3. Whether or not pressure plate 13 acts as a single powerful force to deflect the sheet media is irrelevant.

Furthermore, it is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness, *see* M.P.E.P. § 2143.01. The mere fact that references can be combined or modified does not render the resultant combination or modification obvious unless the prior art also suggests the desirability of the combination, *see* M.P.E.P. § 2143.01 (citing *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). Appellant asserts that *Kazunobu* does not set forth such desirability. Thus, the 103 rejection of record is improper.

Additionally, in establishing obviousness under 35 U.S.C. § 103(a), the proposed modification to the prior art cannot render the prior art unsatisfactory for its intended purpose, *see* M.P.E.P. § 2143.01. As stated in Appellant's specification, registration tabs cast as monolithic members of the lid portion are non-movable tab configurations, *see* [0024]. In *Kazunobu*, pressure plate 13 moves up and down to close the gap between sheet 9 and butting plate 101. *Kazunobu* teaches this method as a means to achieve its intended purpose of preventing original 200 from feeding over butting plate 101, *see* English abstract. Replacing the pressure plate 13 of *Kazunobu* with a non-movable tab would destroy *Kazunobu's* method of preventing original 200 from feeding over butting plate 101. Thus, the proffered modification renders *Kazunobu* unsatisfactory for its intended purpose. Accordingly, Appellant respectfully requests that the improper 35 U.S.C. § 103(a) rejection of record with respect to claim 23 be withdrawn.

IV. CONCLUSION

Appellant believes that each of the pending claims is in condition for allowance, and respectfully requests that the rejections of record be overturned.

I hereby certify that this correspondence is being electronically filed with U.S. Patent and Trademark Office via electronic filing.

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